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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,211	12/03/2003	Wen-Tien Chen	178-295 CIP/CON	5432
23869	7590	07/07/2006	EXAMINER	
HOFFMANN & BARON, LLP 6900 JERICO TURNPIKE SYOSSET, NY 11791			RAWLINGS, STEPHEN L	
			ART UNIT	PAPER NUMBER
			1643	
DATE MAILED: 07/07/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/727,211	Applicant(s) CHEN, WEN-TIEN	
	Examiner Stephen L. Rawlings, Ph.D.	Art Unit 1643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 64-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 64-72 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The second preliminary amendment filed February 25, 2004, is acknowledged and has been entered. Claims 10, 11, 27, and 63 have been canceled. Claims 64-72 have been added.
2. The first preliminary amendment filed December 3, 2003, is acknowledged and has been entered. Claims 1-9, 12-26, and 26-62 have been canceled. Claim 63 has been added.
3. Claims 64-72 are pending in the application and are currently subject to restriction.

Election/Restrictions

4. This application contains claims 64-72 directed to patentably distinct species of the claimed invention, wherein said bispecific antibody is selected from the group consisting of:
 - (a) a bispecific antibody with binding specificity for the epitope of a mammalian dipeptidyl peptidase IV recognized by E19 and for an epitope of seprase;
 - (b) a bispecific antibody with binding specificity for the epitope of a mammalian dipeptidyl peptidase IV recognized by E26 and for an epitope of seprase;
 - (c) a bispecific antibody with binding specificity for the epitope of a mammalian dipeptidyl peptidase IV recognized by E19 and for an epitope of MT1-MMP;
 - (d) a bispecific antibody with binding specificity for the epitope of a mammalian dipeptidyl peptidase IV recognized by E26 and for an epitope of MT-1-MMP;
 - (e) a bispecific antibody with binding specificity for the epitope of a mammalian dipeptidyl peptidase IV recognized by E19 and for an epitope of MMP-2;
 - (f) a bispecific antibody with binding specificity for the epitope of a mammalian dipeptidyl peptidase IV recognized by E26 and for an epitope of MMP-2;

(g) a bispecific antibody with binding specificity for the epitope of a mammalian dipeptidyl peptidase IV recognized by E19 and for an epitope of $\alpha(3)\beta(1)$ -integrin; and

(h) a bispecific antibody with binding specificity for the epitope of a mammalian dipeptidyl peptidase IV recognized by E26 and for an epitope of $\alpha(3)\beta(1)$ -integrin;

Each of the different species of the invention is patentably distinct from the others since each is a bispecific antibody having a binding specificity that is distinct from the others. Accordingly, the examination of claims directed to any one species of invention would require a unique search that is not required for examination of any of the other species of invention; and, the search of any one species will not provide adequate information regarding any other. Accordingly, the search necessary to examine claims directed to any one species of invention is not the same, nor is it coextensive with the search necessary to examine claims directed to any other. Since having to perform more than one search would constitute a serious burden, it is proper to restrict these species of invention and require Applicant to elect only one. See MPEP § 809.

Applicant is required under 35 U.S.C. 121 to specifically elect a single species of invention by identifying the one bispecific antibody to which the claims will be directed during prosecution on the merits, and to which the claims shall be restricted if no generic claim is finally held to be allowable. The Examiner notes that novelty and nonobviousness of the elected species of invention would render claims directed to that species allowable over the prior art, but not necessarily over the requirements set forth under 35 U.S.C. §§ 101 and 112.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, Applicant will be entitled to consideration of claims to additional species, which are written in dependent form, or otherwise, include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If

claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

5. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103(a) of the other invention.


Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Rawlings, Ph.D., whose telephone number is (571) 272-0836. The examiner can normally be reached on Monday-Friday, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms, Ph.D. can be reached on (571) 272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1643

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Stephen L. Rawlings, Ph.D.
Examiner
Art Unit 1643

slr

June 27, 2006